



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,566	11/20/2001	Makoto Okada	1359.1057	8743
21171 7590 05/16/2008				
STAAS & HALSEY LLP				
SUITE 700				
1201 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20005				
EXAMINER				
TRAN, NGHI V				
ART UNIT		PAPER NUMBER		
2151				
MAIL DATE		DELIVERY MODE		
05/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/988,566

Applicant(s)

OKADA ET AL.

Examiner

NGHI V. TRAN

Art Unit

2151

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-7.9 and 10.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/John Follansbee/
Supervisory Patent Examiner, Art Unit 2151

Continuation of 11. does NOT place the application in condition for allowance because:

In response to the Applicant's arguments that neither Thatte nor Klimczak, alone or combination, discloses or suggests "storing contents of an action that is a reaction to the message and adapted to search for a corresponding action with a message body as a search key," the examiner respectfully disagrees. Klimczak discloses storing contents of an action [= action description 324] that is a reaction to the message [= object] and adapted to search for a corresponding action with a message body as a search key. For example, action items relates to the input devices, such as keyboard 114 and mouse 112 and the subscriber could configure appropriate action items to predefine the function of various mouse 112 buttons or keyboard 114 keys [paragraph 0104]. According to dictionary online via <http://www.dictionary.com>, react means to act in return. Configuring appropriate action items to predefine the function of various mouse buttons or keyboard keys is nothing more than acting in return of mouse buttons or keyboard keys. Therefore, Klimczak discloses claimed feature as show in above.

In response to the Applicant's arguments that Klimczak are not reactions to a message, the examiner respectfully disagrees. For example, action items relates to the input devices, such as keyboard 114 and mouse 112 and the subscriber could configure appropriate action items to predefine the function of various mouse 112 buttons or keyboard 114 keys [paragraph 0104]. According to dictionary online via <http://www.dictionary.com>, react means to act in return. Configuring appropriate action items to predefine the function of various mouse buttons or keyboard keys is nothing more than acting in return of mouse buttons or keyboard keys. Therefore, Klimczak discloses claimed feature as show in above.

In response to the Applicant's arguments that "Object actions table" of Klimczak does not store a message and an action which is a reaction to the message, the examiner respectfully disagrees. Applicant's argument does not commensurate with the scope of the claim. The claims only recite the limitation of storing contents of action that is reaction to the message. Klimczak discloses object actions table 318 [see fig.4] stores contents of an action [= action description 324] which is reaction to the message [- object]. For example, action items relates to the input devices, such as keyboard 114 and mouse 112 and the subscriber could configure appropriate action items to predefine the function of various mouse 112 buttons or keyboard 114 keys [paragraph 0104]. According to dictionary online via <http://www.dictionary.com>, react means to act in return. Configuring appropriate action items to predefine the function of various mouse buttons or keyboard keys is nothing more than acting in return of mouse buttons or keyboard keys. However, claim does not recite the limitation of storing a message and an action of which is a reaction to the message (emphasis added). Therefore, Klimczak discloses claimed feature as show in above.

In response to the Applicant's arguments that Klimczak does not cure the deficiencies of Thatte, the examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Thatte in view of Klimczak by storing contents of an action that is a reaction to the message and adapted to search for corresponding action with a message body as a search key because this feature may correspond to many various types functionality relating to the user interface, such as data display, data output and data transfer rather than to database access or database modification privileges [Klimczak, see abstract]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated in order to decide on the subscriber's configuration strategy and to actually input the desired configuration information into the appropriate computer [Klimczak, paragraph 0011].